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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,906	01/09/2002	Greta Arnaut	58764.000036	1498

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/040,906

Applicant(s)

ARNAUT ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 1/17/06. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): objection to claim 71; 112, 2nd of claim 77.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 83 under 102(e) over Baum: Applicant urges that Baum et al does not disclose protecting a plant from *Anticarsia gemmatilis*. This is not found persuasive because applying the protein of SEQ ID NO:2, as taught in Baum, would inherently be a method of protecting a plant from *A. gemmatilis*. Applicant urges that claim 83 is non-obvious. This is not persuasive, as the rejection is one of anticipation, not obviousness.

Claims 58, 77 and 80 under 103(a) over Baum in view of Audtho and further in view of Schnepf: Applicant urges that the prior art does not provide any motivation to combine the reference teachings because the prior art does not teach or suggest the desirability of Applicant's invention; Audtho discloses Cry2Ae and there is no motivation to combine the disclosures. This is not found persuasive because Schnepf provides the motivation - truncation allows more effective expression in plants and avoids insect resistance (pg 793, left column, paragraph 3, and pg 795, left column, paragraph 2). Applicant urges that the Office action does not explain why one would be motivated to apply teachings relating to one protein to a different protein with about a 10% sequence difference. This is not found persuasive. Schnepf indicates that truncation improved expression with several different Cry proteins (pg 793, left column, paragraph 3) and a desire to avoid insect resistance is not limited to only one Cry protein. Applicant urges that Corbin et al demonstrates that different Cry2A protein types act in different manners when expressed in plants. This is not found persuasive, as Corbin et al is not drawn to truncation but to addition of the TpssuAt transit peptide to a Cry protein. Applicant urges that Schnepf does not provide motivation to combine, as the cited papers are drawn to Cry1Aa and Cry1Ab proteins that were truncated at their C-terminus. This is not found persuasive; without the cited papers, Applicant's arguments are only unsupported assertions. The cited papers were not sent and could not be considered even if they were, as Applicant must provide a good and sufficient reason why they are necessary and not sent earlier. Additionally, Audtho et al teaches that proteolytic activation of the protoxin is an important factor in insect resistance to the toxin (pg 4603, right column, paragraph 2) and that the protein with the 49 amino acid truncation was more toxic than the 63KDa protein (table 1). Applicant urges that the statement in Schnepf is general and not directed to a specific Cry protein, and that the Cry2A proteins are already the size of a truncated Cry1A protein. This is not found persuasive because the Cry2A proteins are the size of the C-terminal truncated Cry1A proteins, not the N-terminal truncated proteins.

Claims 71 and 76 under 35 U.S.C. 103(a) over Baum in view of Meulewaeter; Applicant urges that their amending the dependence to claim 57 and 58 makes the claim non-obvious. This is not found persuasive, as Claim 58 is obvious, as discussed above. The rejection because of Applicant amendment of the claims would be over Baum in view of Audtho and further in view of Schnepf and Meulewaeter.



ANNE KUEHL, Ph.D.
PRIMARY EXAMINER